

## **REMARKS**

The Office Action dated February 6, 2009 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 31, 36, 49, 76, 82, 85, and 98 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 42, 43, 45-48, 78, 79, 90-97, and 114-120 have been withdrawn in view of the restriction requirement. Claim 51 has been cancelled without prejudice and/or disclaimer.

In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections to the claims for the reasons discussed below.

### **Restriction Requirement**

The Office Action of February 6, 2009 presented a restriction requirement, requiring election between one of the following two inventions:

- Invention I, directed to claims 31, 49, 55, 76, 80, 81, 82, 85, 98 and 106, and their respective dependent claims, drawn to a process of identifying different networks (e.g. scanning, registration and system selection), classified in class 455, subclass 435.1 or 435.2.
- Invention II, directed to claims 31 and 38 together, 42, 78, 90, 94, 114 and 120 (and their respective dependent claims), drawn to a handoff process (e.g. network or mobile initiated), classified in class 455, subclass 436, 437, and 438.

Applicant respectfully elects to prosecute, with traverse, the subject matter of Invention I, recited in claims 31, 49, 55, 76, 80, 81, 82, 85, 98 and 106, and their respective dependent claims, which are allegedly drawn to a process of identifying different networks. Applicant therefore respectfully requests timely consideration on the merits.

Applicant reserves the right to file a divisional application on the non-elected claims at any point prior to the termination of the proceedings in the subject application.

Applicant respectfully traverses this restriction, because claim 31 is a generic claim, as claim 31 is categorized under both inventions I and II. In addition, Applicant further traverses this restriction on the grounds that the Office's reasoning for restricting the invention is improper.

The MPEP requires that the Office, when making a restriction, must establish that the (1) inventions are independent and (2) there is a serious burden on the Examiner if the restriction is not required. See MPEP § 803(I). In order to establish a serious burden, the Office must show, at least the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status

in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

See MPEP § 808.02. Clearly the Office has not provided any of the above-mentioned reasoning to establish that there would be a serious burden on the Examiner if the restriction is not required. Instead the Office merely asserted that the sheer number of claims provides a large burden on the Examiner. See Office Action, page 2, last paragraph. The sheer number of claims is not appropriate to establish a serious burden, since the sheer number of claims is not even a factor in considering whether a serious burden is present if the Examiner is required to examine the claims. In fact, the Office has conceded that there is no serious burden by explicitly stating that the sheer number of claims merely provide a large burden and not a serious burden.

Therefore, in view of the above, Applicant respectfully requests that the restriction requirement be withdrawn, as there is no serious burden on the Examiner to examine all of the claims.

### **Rejections under 35 U.S.C. § 101**

Claims 81, 85, 94, and 106 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, it was asserted in the Office Action that there is no written information in the specification for the term “computer readable medium”, and therefore there is no support for these claims. However, Applicant respectfully traverses this rejection as follows.

Applicants respectfully submit that 35 U.S.C. § 101 does not dictate whether or not the specification supports the recitation recited in the claims. Instead, 35 U.S.C. § 101 is directed to statutory subject matter. When a claim recites computer-related subject matter, MPEP § 2106 dictates whether or not the subject matter recited in the claim is statutory. MPEP § 2106 states, in part, “descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material. In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component.” MPEP § 2106 further states that “when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” In the instant case, claim 81 recite functional descriptive material (i.e. computer program). Moreover, the fact that, in claim 81, the

“computer readable medium [is] encoded with a computer program” further establishes that claim 81 is statutory per se under MPEP § 2106.01 and 35 U.S.C. § 101.

Claims 85 and 106, which each have their own scope, recite “computer program” being embodied on a “computer readable medium”, as similarly recited in claim 81. Therefore, claims 85 and 106 satisfy the requirements under 35 U.S.C. § 101 for reasons similar to those discussed above with respect to claim 81.

The rejection of claim 94 is moot, since claim 94 has been withdrawn from consideration.

Regarding the rejection of claims 31, 36, 49, 82, 90, and 98, it was asserted in the Office Action that these claims recite method steps that are not limited from only occurring in a computer processor (which is allegedly non-statutory), and, therefore requested that the Applicant amend these claims to identify how/where these methods are being performed.

Regarding claim 31, Applicant respectfully submits that claim 31, as amended, clearly recites how/where the functional limitations recited in claim 31 are being carried out. For example, claim 31, as amended, clearly recites that a **processor** (e.g. a structural component) is configured to **identify** (e.g. functional feature) a cell of a first telecommunication network as a neighboring cell by using cell identity information for a cell of the first telecommunication network and a cell identity information structure of the second telecommunication network. For the Office to indicate that a computer processor is non-statutory is improper. A processor is not and could not be considered to be non-

statutory under 35 U.S.C. § 101, since a processor is a structural component. The fact that the processor is configured to carry out the above-mentioned feature in claim 31 further establishes that the processor could not be considered to be non-statutory under 35 U.S.C. § 101.

Therefore, Applicant respectfully requests that the rejection of claim 31 and claims 39, which depends upon claim 31, be withdrawn.

Regarding claim 82 and 98, the Applicant has amended these claims to particularly to point how and where each step in method claims 82 and 98 is being carried out. Therefore, for reasons similar to those discussed above with respect to claim 31, Applicant respectfully requests that the rejection of claims 82 and 98 be withdrawn.

The rejection of claims 49 and 90 is considered moot, as these claims have been withdrawn from consideration.

Regarding the rejection of claims 49, 82, 90, and 98, it was asserted in the Office Action that these claims do not fall within one of the four statutory categories under 35 U.S.C. § 101. In particular, it was asserted in the Office Action that the claims recite a series of steps or acts to be performed without being tied to another statutory category or transforming the underlying subject matter to a different state or thing. It appears that the Office Action is relying upon the holding from *In re Bilski*. *In re Bilski* held that a “claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing.

See Benson, 409 U.S. at 70 (‘Transformation and reduction of an article ‘to a different state or thing’ is the clue to patentability of a process claim that does not include particular machines’))” (see Slip op. at 10 and 11 (Fed. Cir. 2008)).

Without conceding to the allegations set forth in the Office Action, the Applicants have amended method claims 82 and 98 to satisfy the first (1) prong (e.g. tied to a particular machine or apparatus) from *In re Bilski*. Accordingly, withdrawal of the rejection with respect to claims 82 and 98 is respectfully requested.

Regarding claims 49 and 90, the rejection of these claims is moot, as claims 49 and 90 have been withdrawn from consideration.

### **Rejections under 35 U.S.C. § 112**

Claims 81, 85, 94, and 106 were rejected under 35 U.S.C. § 112, first paragraph, for having a disclosure that is non-enabling. In particular, it was asserted in the Office Action that the disclosure of a computer program critical or essential to the practice of the invention is not enabled by the disclosure. In other words, it was indicated in the Office Action that there is no evidence/support in the specification or figures to contemplate a computer program. However, Applicant respectfully traverses this rejection as follows.

The figures of the application clearly show a mobile station, a base station, a network management system, etc. Applicant respectfully submits that a person of ordinary skill in the art would clearly understand that each one of the above-mentioned machines include a

computer readable medium. A person of ordinary skill in the art would further understand that the computer readable medium would be encoded with a computer program to control the processor, the receiver, the transmitter, etc., to carry out the features recited in the claimed invention.

For the Office Action to merely state “no evidence/support [is found] in the specification (or figures) that a computer program was contemplated” is improper. As indicated in the December 5, 2008 Response, when the Office determines that an application is not enabling, the Office must set forth a prima facie case establishing that the experimentation needed to practice the invention was undue or unreasonable. See MPEP § 2164.01. To establish such a case, the Office must take into account the following factors to determine that the experimentation needed is undue. These factors, which are listed below, were laid out in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)):

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See MPEP § 2164.01(a). A proper analysis of whether any experimentation is undue requires an analysis of all of the Wands factors. See MPEP 2164.01(a). It is improper to



conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. See Id.

As clearly demonstrated by the Office Action, none of the factors were used in determining whether the disclosure is non-enabling. Therefore, it is apparent that the Office Action has failed to demonstrated, once again, why the present application is non-enabling.

Furthermore, as discussed above, the figures of the application clearly provide support to enable one skilled in the art as to how to make and use the claimed invention. Therefore, Applicant respectfully submits that the claims 81, 85, and 106 fully satisfy the requirements under the first paragraph of 35 U.S.C. § 112. Accordingly, Applicants respectfully requests that the rejection of claims 81, 85, and 106 be withdrawn for at least the reasons presented above.

The rejection of claim 94 is considered moot, as this claim has been withdrawn.

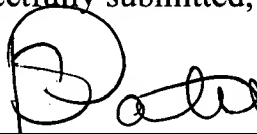
Claims 31, 36, 49, 82, 90, and 98 were rejected under 35 U.S.C. § 112, second paragraph, for being incomplete by omitting essential elements. For example, it was asserted in the Office Action that these claims merely recite steps but do not recite where these steps are being performed. However, Applicant respectfully submit that the amendments made to claims 31, 82, and 98 and the arguments presented above fully recite where the steps at issue are being performed. Accordingly, withdrawal of the rejection of claims 31, 36, 82, and 98 is respectfully requested.

The rejection of claims 49 and 90 is moot, as these claims have been withdrawn from consideration.

### **Conclusion**

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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